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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/051,697	01/18/2002	William D. Castell	555255012306	1441
7590	02/24/2005		EXAMINER	
David B. Cochran, Esq. Jones, Day, Reavis & Pogue North Point 901 Lakeside Ave Cleveland, OH 44114			CHOW, MING	
			ART UNIT	PAPER NUMBER
			2645	
DATE MAILED: 02/24/2005				

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)
	10/051,697	CASTELL ET AL.
	Examiner	Art Unit
	Ming Chow	2645

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

**A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM
 THE MAILING DATE OF THIS COMMUNICATION.**

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) Responsive to communication(s) filed on 14 June 2004.
- 2a) This action is **FINAL**. 2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) Claim(s) 6-52 is/are pending in the application.
 - 4a) Of the above claim(s) 46-52 is/are withdrawn from consideration.
- 5) Claim(s) _____ is/are allowed.
- 6) Claim(s) 6-45 is/are rejected.
- 7) Claim(s) _____ is/are objected to.
- 8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on _____ is/are: a) accepted or b) objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
 - a) All b) Some * c) None of:
 1. Certified copies of the priority documents have been received.
 2. Certified copies of the priority documents have been received in Application No. _____.
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)	4) <input type="checkbox"/> Interview Summary (PTO-413)
2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)	Paper No(s)/Mail Date. _____.
3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____.	5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)
	6) <input type="checkbox"/> Other: _____.

Election/Restrictions

1. Applicant's election without traverse of claims 1-5 in the reply filed on 6-14-04 is acknowledged.

Applicant further cancelled the elected claims 1-5 in the reply filed on 6-14-04.

2. Newly submitted claims 46-52 directed to an invention that is independent or distinct from the invention originally claimed for the following reasons:

Claims 46-48 draws to a method of conference calls on a PBX, classified in class 379 subclass 202.01.

Claims 49-52 draws to a method of call waiting (on-hold call), classified in class 379 subclass 215.01.

Since applicant has received an action on the merits for the originally presented invention, this invention has been constructively elected by original presentation for prosecution on the merits. Accordingly, claims 46-52 withdrawn from consideration as being directed to a non-elected invention. See 37 CFR 1.142(b) and MPEP § 821.03.

Response to Amendment

3. The amendment filed on 6-14-04 is objected to because footers of all pages are marked as "Copied from 10051194 on 09/01/2004". The footers do not comply to the required format of specification and the cited application is irrelevant to the current application. Applicant is required to delete the footers at the next reply, if any.

Allowable Subject Matter

4. Claim 44 is objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims. The prior art does not teach a connection request is sent from a dual-mode wireless device via a wireless data network to a unified messaging system. And, the voicemail system (that is integrated into a unified messaging system) initiates a voice call to the dual-mode wireless device via a wireless voice network. The voicemail system as taught by Smith et al is connected by a connection initiated by the wireless device. It is not obvious to modify the system of Smith et al for the voicemail system receives the request and initiates a voice connection from the voicemail system to the wireless device.

5. Claim 45 would be allowable, because claim 45 depends on an allowable claim 44, if rewritten to overcome the rejection(s) under 35 U.S.C. 112, 1st paragraph, set forth in this Office action and to include all of the limitations of the base claim and any intervening claims.

Claim Objections

6. Claims 6, 7, 8, 10, 18 recite the limitation "the steps" (line 4) and "the user" (line 6). There is insufficient antecedent basis for this limitation in the claim. This objection also applies to other claims where "the steps" is claimed and is lack of antecedent basis.

7. Claims 7, 8 (and other claims) recite the limitation "the step". There is insufficient antecedent basis for this limitation in the claim.

8. Claim 9 recites the limitation "the call". There is insufficient antecedent basis for this limitation in the claim.

9. Claim 18 recites the limitation "the operation". There is insufficient antecedent basis for this limitation in the claim.

10. Claim 23 recites the limitation "the command message". There is insufficient antecedent basis for this limitation in the claim.

11. Claims 31, 35 recite the limitation "the date and time". There is insufficient antecedent basis for this limitation in the claim.

12. Claim 33 recites the limitation "the graphical icon" (including claim 34) and "the received email messages". There is insufficient antecedent basis for this limitation in the claim.

Drawings

13. The drawings are objected to because proper legends, for example, items 110b, 130 Fig. 1, item 240 Fig. 2, item 312, 313, 316 Fig. 5 (this is not intended to be a complete listing), were missing. A proposed drawing correction or corrected drawings are required in reply to the Office action to avoid abandonment of the application. The objection to the drawings will not be held in abeyance.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

14. Claim 12 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The phrase “the list of options voice mail control options” (line 4) is not clearly defined. The Examiner cannot understand the claimed phrase.
15. Claims 18, 30 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The phrase “receiving the stored voice call” (line 12) is not clearly defined. A voice call refers to a “live” call and the call itself can be either held, forwarded, or disconnected. The call itself cannot be stored. A call message can be stored.
16. Where applicant acts as his or her own lexicographer to specifically define a term of a claim contrary to its ordinary meaning, the written description must clearly redefine the claim term and set forth the uncommon definition so as to put one reasonably skilled in the art on notice that the applicant intended to so redefine that claim term. *Process Control Corp. v. HydReclaim Corp.*, 190 F.3d 1350, 1357, 52 USPQ2d 1029, 1033 (Fed. Cir. 1999). The term “dual-mode” in claim 18 (and others) is used by the claim to mean “communicating via wireless

data network and wireless voice network", while the accepted meaning is "communicating analog and digital audio signals." The term is indefinite because the specification does not clearly redefine the term.

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

The following shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

17. Claim 10 is rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. The phrase "the set of DTMF tones are silent tones" is not disclosed by the specification. Nowhere in the specification disclosed a set of DTMF tones are silent tones. Also, the DTMF tones are old and well known to one skilled in the art. There are NO DTMF tones that are silent.

18. Claim 13 is rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. The phrase “the command signal is transmitted via the voice communication channel” is not disclosed by the specification. The specification disclosed the command signal is transmitted via data channel but not the voice channel.

19. Claim 26 is rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. The phrase “determining whether the dual-mode wireless device is associated with the voicemail box prior to transmitting the notification message” is not disclosed by the specification. Nowhere in the specification disclosed this limitation.

20. Claim 28 is rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. The phrase “the email messages are stored at a corporate email server” is not disclosed by the specification. Nowhere in the specification disclosed this limitation.

21. Claim 32 is rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to enable one skilled in the art to

which it pertains, or with which it is most nearly connected, to make and/or use the invention.

The phrase “email message events and voicemail events received at the dual-mode wireless device” is not disclosed by the specification. The “events” refers to “receiving email messages and voicemail messages”. The email messages and voicemail messages are received on the unified messaging system but NOT on the wireless device when the listing of events is displayed.

22. Claim 42 is rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention.

The phrase “mapping the commands on the command list into voicemail system operating commands” is not disclosed by the specification. Nowhere in the specification discloses the operation of the “mapping”.

Also, the phrase “after a command is selected, transmitting.....operating commands” is not disclosed by the specification. The specification did not support when “one” command is selected multiple operating commands (plural) are transmitted.

23. Claim 45 is rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. The phrase “the dual-mode wireless device.....detecting caller identification information of the voicemail system” is not disclosed by the specification. The specification, on line 22 page 30 to

line 1 page 31, disclosed “recognizes incoming call from the PBX system”. The specification did not disclose recognizing caller identification information of the voicemail system.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) and the Intellectual Property and High Technology Technical Amendments Act of 2002 do not apply when the reference is a U.S. patent resulting directly or indirectly from an international application filed before November 29, 2000. Therefore, the prior art date of the reference is determined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

24. Claims 6, 7, 9-12, 14, 18, 22, 23, 26, 30-36, 38, 41-43 are rejected under 35 U.S.C. 102(e) as being anticipated by Smith et al (US: 6333973).

For claims 6, 7, 9, 10, 11, 13, 14, 18, 30, 31, Smith et al teach on Fig. 5, a unified messaging system including voicemail, FAX, and email servers (claimed “data store”). Smith et al teach on Fig. 2, wireless mobile communication device.

Smith et al teach on column 4 line 21-24, storing the voicemail and sending a short message notifying the user of the pending voicemail. Smith et al teach on column 7 line 51-55, the notification includes caller’s name and telephone number, and a time and date stamp (claimed “information regarding the voicemail message”).

Smith et al teach on Fig. 7A and 7B, displaying voicemail message information on the display interface. Smith et al teach on column 9 line 54-60, selecting the voicemail icon to play the voicemail. Therefore, each display entry is a message retrieval command. Smith et al teach on column 9 line 62-65, the command is translated into DTMF tones to control voicemail server. The command (DTMF tones) must be transmitted from the mobile device to the unified messaging system.

Smith et al teach on column 10 line 1-2, playback the voicemail (transmitting the voicemail to the mobile device.

Regarding claim 12, see column 9 line 44-53.

Regarding claim 22, see Fig. 5 and column 4 line 1-7 .

For claim 23, regarding “transmitting the command signal via the wireless data network”, the rejections as stated in claim 14 above apply.

Regarding “receiving the command signal....to the voice mail system”, the command signal must be routed to the voicemail server from the unified messaging system as the voicemails are stored in the voicemail server.

Regarding claim 26, Smith et al teach on column 4 line 16-24. the unified messaging system stores the message and sends a short message to the mobile telephone notifying the user of the pending voicemail message. The unified messaging system must associate the pending voicemail with the wireless device for sending the notification.

Regarding claims 32, 33, see Fig. 7A and 7B.

Regarding claims 34, 35, see column 6 line 3-6 and Fig. 10.

Regarding claim 36, see column 9 line 54-60.

Regarding claim 38, see column 9 line 50.

Regarding claim 41, see Fig. 10.

Regarding claims 42, 43, see column 9 line 61-65.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

25. Claims 8, 17, 27-29 are rejected under 35 U.S.C. 103(a) as being unpatentable over Smith et al, and in view of Brilla et al (US: 6389276).

Regarding claims 8, 17, 27, 29, Smith et al failed to teach “an email message including the information regarding the voice mail message and transmitting the email message to the mobile device”. However, Brilla et al teach on column 17 line 10-20, voicemail notification by emails.

It would have been obvious to one skilled at the time the invention was made to modify Smith et al to have “an email message including the information regarding the voice mail message and transmitting the email message to the mobile device” as taught by Brilla et al such that the modified system of Smith et al would be able to support the system users convenience of using email for notifications.

Regarding claim 28, rejections as stated in claim 27 above apply.

The modified system of Smith et al in view of Brilla et al failed to teach “corporate email server”. However, where or whom the server belongs to is a “Decide Choice”.

It would have been obvious to one skilled at the time the invention was made to modify Smith et al in view of Brilla et al to have “a corporate email server” such that the modified system of Smith et al in view of Brilla et al would be able to support the system users full messaging notification service in a corporate environment.

26. Claims 13, 24 are rejected under 35 U.S.C. 103(a) as being unpatentable over Smith et al, and in view of Parikh et al (US: 6408177).

Smith et al failed to teach “the command signal is transmitted via the voice communication channel”. However, Parikh et al teaches on Fig. 1, spoken menu selection is received via the voice channel.

It would have been obvious to one skilled at the time the invention was made to modify Smith et al to have “the command signal is transmitted via the voice communication channel” as taught by Parikh et al such that the modified system of Smith et al would be able to support the system users convenience of using audio commands via voice channel.

27. Claims 15, 19, 20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Smith et al, and in view of Swistock (US: 6389115).

Smith et al teach on item 5600 Fig. 5, a voicemail server (claimed “voicemail system”) integrated within the unified messaging system.

Smith et al failed to teach “a PBX coupling the voicemail system to a wireless voice network”. However, Swistock teaches on Fig. 1A, a PBX coupling a voicemail system to a wireless voice network.

It would have been obvious to one skilled at the time the invention was made to modify Smith et al to have “a PBX coupling the voicemail system to a wireless voice network” as taught by Swistock such that the modified system of Smith et al would be able to support the system users convenience of using a PBX to couple the voicemail system and the wireless voice network.

28. Claims 16, 25 are rejected under 35 U.S.C. 103(a) as being unpatentable over Smith et al, and in view of Parikh et al and further in view of Swistock.

The rejections as stated in claims 13 and 15 above apply.

It would have been obvious to one skilled at the time the invention was made to modify Smith et al to have “transmitting the command signal via a voice channel” as taught by Parikh et al and “transmitting the command signal to the voicemail system via the PBX” as taught by Swistock such that the modified system of Smith et al would be able to support the system users convenience of transmitting command signals, via a voice channel, to the voicemail system through the PBX.

29. Claim 21 is rejected under 35 U.S.C. 103(a) as being unpatentable over Smith et al. Smith et al teach on Fig. 7A and 7B, reference identification in the notification message.

Smith et al failed to teach “including the reference identification in the command signal”. However, “Official Notice” is taken that including the identification in the “retrieving message” command to access the desired message is old and well known to one skilled in the art.

It would have been obvious to one skilled at the time the invention was made to modify Smith et al to have “including the reference identification in the command signal” such that the modified system of Smith et al would be able to support the system users convenience of selecting the desired message without worrying detail information included in the command.

30. Claim 37 is rejected under 35 U.S.C. 103(a) as being unpatentable over Smith et al, and in view of Helperich (US: 6636733).

Smith et al failed to teach “the connection request includes a voice phone number of the voice mail system”. However, Helperich teaches on column 1 line 59 to column 2 line 8, calling from a wireless device to a voice message system. The calling request must have a phone number.

It would have been obvious to one skilled at the time the invention was made to modify Smith et al to have “the connection request includes a voice phone number of the voice mail system” such that the modified system of Smith et al would be able to support the system users convenience of dialing into the voicemail system.

31. Claim 39 is rejected under 35 U.S.C. 103(a) as being unpatentable over Smith et al, and in view of Saylor et al (US: 6792086).

Smith et al failed to teach “the authentication utilizes caller identification information associated with the dual-mode wireless device”. However, Saylor et al teach on column 17 line 10-11, a caller calls into a system and is authenticated by the caller ID.

It would have been obvious to one skilled at the time the invention was made to modify Smith et al to have “the authentication utilizes caller identification information associated with the dual-mode wireless device” such that the modified system of Smith et al would be able to support the system users convenience of authentication simply by the caller ID.

32. Claim 40 is rejected under 35 U.S.C. 103(a) as being unpatentable over Smith et al, and in view of Owens et al (US: 5481611).

Smith et al failed to teach “DTMF password”. However, Owens et al teach on column 10 line 16-17, using DTMF tones for encoding passwords.

It would have been obvious to one skilled at the time the invention was made to modify Smith et al to have “STMF password” such that the modified system of Smith et al would be able to support the system users convenience of sending passwords by DTMF tones.

Response to Arguments

33. Applicant's arguments filed on 6/14/04 have been fully considered.

- i) Applicant argues, on page 15, regarding objections to the drawings. The objections have been clearly stated in the previous and current office actions. Applicant may refer to 37 CFR 1.84(o) for this objection.

Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Art Unit: 2645

34. Any inquiry concerning this application and office action should be directed to the examiner Ming Chow whose telephone number is (703) 305-4817. The examiner can normally be reached on Monday through Friday from 8:30 am to 5 pm. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Fan Tsang, can be reached on (703) 305-4895. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Customer Service whose telephone number is (703) 306-0377. Any response to this action should be mailed to:

Commissioner of Patents and Trademarks

Washington, D.C. 20231

Or faxed to Central FAX Number 703-872-9306.

Patent Examiner

Art Unit 2645

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